

Remarks

In the non-final Office Action dated June 10, 2009, the following rejection is maintained: claims 1-15 stand rejected under 35 U.S.C. § 102(a) over TransDimension (TransDimension OTG243 Product Brief). In the discussion set forth below, Applicant does not acquiesce to any rejection or averment in the instant Office Action unless Applicant expressly indicates otherwise.

Applicant's representative telephoned the Examiner to discuss the lack of any firm publication date in the TransDimension reference. Based upon the Examiner's return telephone message, it is understood that the Examiner intended to discuss this matter with the SPE, but was unsure as to whether that discussion would be possible in advance of the three-month response date. As the three-month response date is nearing, this paper is being submitted at this time without further delay. Applicant appreciates the Examiner's efforts, and further invites the Examiner to telephone the undersigned if appropriate.

Applicant submits that all § 102 rejections are improper because the Office Action has not established that the TransDimension reference, upon which all rejections rely, was publicly available before Applicant's priority date. The Office Action has therefore failed to comply with the requirements of § 102(a) and M.P.E.P. § 2128.01(III). Specifically, the TransDimension reference is a "proprietary" (*e.g.*, private) product brief that is dated March 25, 2002, which is not indicative of any date that the product or the brief was subsequently made public. As is often the case with new products, literature and other information is prepared and maintained as proprietary (private) until a later date at which the product or literature is released to the public. In this instance, while the reference may have been made public sometime on or before the Examiner's December 24, 2008 Internet search, nothing in the record establishes that the TransDimension reference was published (prior art under § 102) before Applicant's priority date of September 24, 2002, which is more than *six years* before the Examiner's search.

The Examiner's attempt to support the asserted priority is also erroneous because it impermissibly attempts to shift the burden of ascertaining the reference's priority date to the Applicant contrary to § 102. Specifically, the Office Action's assertion that "the fact that the reference is marked "preliminary" and "proprietary" does not render the

reference not accessible to the public” does not establish any priority date or afford the Applicant the opportunity to adjudge the same. Whether the reference *could* have been made accessible is not at issue; what is at issue is whether the reference actually *was* made public, and this is what the Office Action has failed to establish. The Examiner’s further discussion of another TransDimension product brief that is also marked “proprietary” again fails to establish any accurate publication date, and further appears to confuse the word “preliminary” with the word “proprietary” (private).

In short, nothing in the record would establish the sole TransDimension reference as prior art. None of the assertions regarding the indicated “proprietary” date on the TransDimension reference provide any factual basis upon which to establish any date that the reference was made public, prior to the Examiner’s search as carried out more than six years after the priority date of the instant Office Action. As this is now the second time that this reference has been asserted, and as the Office Action has again failed to produce a publication date of the reference any earlier than December 24, 2008, Applicant submits that the rejection must be reversed and requests immediate allowance of all claims.

In addition to the above, and while further review of the TransDimension reference is believed unnecessary, Applicant further submits that the Office Action has failed to establish correspondence between the cited reference and multiple limitations. Regarding the independent claims, the Office Action has not asserted any correspondence to limitations including those directed to “sequencing USB communication via the transceiver with a host controller in the interface integrated circuit and communicating USB transceived data to or from functional circuits outside the integrated circuit via a parallel address data interface when USB host operation is selected” (see claim 6 and claims 7-8 that depend therefrom). Applicant has reviewed the TransDimension reference and cannot ascertain any discussion whatsoever of sequencing any USB communications, or of related limitations directed to communicating transceived data via a parallel address data interface when host operation is selected.

Further regarding independent claim 1 (and as applicable to other independent claims), the Office Action has not established that the “OTG transceiver” in Figure 1 corresponds to “a transceiver capable of transceiving for both a USB host and a USB

device” and “having a USB interface, a host interface and a device interface” as claimed. The circuit shown in Figure 1 in the TransDimension reference uses three separate transceivers, and the Office Action (or the cited description) does not establish that any of these separate transceivers could or does function in accordance with the claimed invention. These separate receivers are used in accordance with the indicated purpose of the “On-the-Go dual-role device” described in the TransDimension reference, which uses “one OTG port plus a standard USB host with two downstream ports” (see page 1, as is also consistent with the software stack diagram in Figure 2). The TransDimension reference thus not only fails to disclose the claimed invention, it teaches away from the same (contrary to M.P.E.P. § 2143.01).

In view of the above, not only has the Office Action failed to establish the TransDimension reference as prior art, it has failed to assert correspondence to multiple claim limitations, and has further misinterpreted the cited transceivers and related circuits therein (which fail to correspond to the claimed transceiver circuit that functions both as a USB host and as a USB device). The Office Action has thus failed to establish that the TransDimension reference corresponds to these limitations and to the claimed invention as a whole (*e.g.*, “to provide USB apparatus that are capable of functioning both as host and as device” as discussed at paragraph 0010).

Applicant therefore believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 

Name: Robert J. Crawford
Reg. No.: 32,122
Eric J. Curtin
Reg. No.: 47,511
651-686-6633
(NXPS.388PA)